

REMARKS

These remarks are set forth in response to the non-final office action mailed July 8, 2005 (the "Office Action"). As this amendment has been timely filed within the three-month statutory period, neither an extension of time nor a fee is required. Presently, claims 1 through 13 are pending in the Patent Application. Claims 1, 7 and 8 are independent in nature.

1. Double Patenting Rejection

In the Office Action, claims 1 through 13 have been provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 through 12 of co-pending United States Patent Application Serial No. 10/741,733 to Creamer. In response, the Applicants have enclosed a fully executed terminal disclaimer sufficient to overcome the stated obviousness type double-patenting rejection.

2. Rejections on the Art

In the Office Action, each of claims 1-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,744,877 to Edwards et al. (Edwards) in view of Florida Citizens Now Able to Renew Vehicle Registration Via Telephone, in Business Wire at 2272 (April 11, 2001) (Florida), or Wisconsin is Set to Jump on the Credit Card Bandwagon (Faulkner & Gray 1992) (Wisconsin), or Digital Launches Industry's First Time-Based Debit Card Service, in PR Newswire at 1110 (November 10, 1997) (Digital). Also, claims 1-6 and 8-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,411,692 to Sherer et al. (Sherer) in view of Florida, Wisconsin, or Digital.

3. Applicants' Amendments

In response, the Applicants have amended claims 1, 2, 7, 8 and 9 in an effort to clarify the distinctions between the cited art and the Applicants' invention. Specifically, the Applicants have amended claims 1, 2, 7, 8 and 9 to indicate that the service subscriber for a telephone call can be identified through information received externally to the telephone call from a switch in the PSTN as shown in Figures 1 and 2 of the Applicants' patent application. In comparison to Sherer, for instance, the identifying information for a caller is placed in the ANI fields of the telephone call itself which travel to the called party. Figure 7A of Sherer clearly illustrates that the "call standard data field is modified to carry additional information about caller (for example: ANI field is changed to CSI). Likewise, in Edwards, the caller information is extracted from ANI or DNIS as shown in Figure 3 of Edwards.

4. Characterization of the Art

As described in the Sherer Abstract, Sherer relates to a "system for providing caller information to called party via call standard data field". Specifically, in Sherer, "a standard data field in a telephone system call format, such ANI and/or dialed number is changed to reflect caller and/or call specific information." "The caller and/or call specific information is made available to a called party, and elements of the telephone switching system." Similarly, in Edwards as shown in Figure 3, ANI and DNIS are used to identify the caller. Florida and Wisconsin in turn relate to the use of the telephone to renew drivers' licenses. Finally, Digital relates to the purchase of telephone support services in a stored value card.

Importantly, none of Sherer, Edwards, Florida, Wisconsin and Digital teaches the identification of a subscriber over a telephone call using identifying information received externally to the telephone call. Rather, Sherer and Edwards explicitly require the use of information (ANI/DNIS) acquired from within the telephone call. Amended claims 1, 7 and 8 each require that a calling service subscriber is identified through identifying information received externally to the telephone call placed by the subscriber and within a switch in the PSTN. Yet, in Sherer and Edwards, the identity of the subscriber is obtained through identifying information received internally to the telephone call placed by the subscriber--namely the ANI information which is included at the header of the telephone call as described. As it is known in the art, ANI information is provided by sending the digital tone multi frequency (DTMF) tones identifying the calling party along with the call.

5. No Motivation to Combine References Present in References

While Sherer and Edwards address the identification of a calling party, no motivation evident within the references has been cited to support the combination of Sherer and Edwards with Florida, Wisconsin or Digital. In this regard, in the fourth paragraph of page 3, in the fifth paragraph of page 5 and in the seventh paragraph of page 7 of the Office Action, the Examiner asserted the following motivation to combine:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Sherer [Edwards] thus making it possible to extend or renew services without having to go to the service provider in person, saving transportation cost, providing convenience and to be able to use desired service before/after expiration.

The entire cited portion which represents the Examiner's motivation to combine does not speak to the combination of the secondary references with Sherer and Edwards, e.g. the identification of a caller using information provided externally to the phone call.

It has been repeatedly held by the Court of Appeals for the Federal Circuit that in order to establish the requisite motivation, the Examiner must make "clear and particular" factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify a particular prior art reference to arrive at the claimed invention based upon facts, not generalizations.¹

6. No Hindsight Reasoning Permitted

Furthermore, it has also been held that one having ordinary skill in the art does not have the benefit of hindsight of Applicant's invention.² As stated in M.P.E.P. § 2142, entitled "Legal Concept of Prima Facie Obviousness":

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (emphasis added)

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the Federal Circuit decision of In re Lee.³ This case involved an appeal of a decision of the Board of Patent Appeals (hereinafter the Board) in which Lee argued that the Examiner failed to provide a factual evidence of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The

¹ Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolchem Inc. v. Southern California Edison, Co., 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

² Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

³ 277 F.3d 1338 (Fed. Cir. 2002).

Board responded to Lee's argument by ruling "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the Administrative Procedure Act." The Court stated:

Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. (emphasis added)

The Court then focused on the failure by the Patent and Trademark Office (PTO) to provide a factual basis for the motivation to combine the applied prior art. For example, the Court stated:

"The factual inquiry whether to combine references must be thorough and searching." ... It must be based on objective evidence of record. This precedent has been reinforced in myriad of decisions, and cannot be dispensed with. (emphasis added)

On the basis of several previous decisions that call for specificity and factual support in the PTO's rejections, the Court attacked the Examiner's conclusory statements regarding the obviousness of the proposed combination as being factually unsupported. With regard to the Board decision, the Court stated:

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of [] references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The Court also stated that the PTO is "not free to refuse to follow circuit precedent" and "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims."

In the instant case, the asserted motivation for modifying the Sherer and Edwards references with the secondary references, which is to "make it possible to extend or renew services

without having to go to the service provider in person, saving transportation cost, providing convenience and to be able to use desired service before/after expiration" lacks factual support and comports very closely to the analysis disapproved by the Federal Circuit in In re Lee. The Examiner has not provided any factual basis establishing that one having ordinary skill in the art would have believed that modifying the teachings of Sherer and Edwards in view of any of Florida, Wisconsin or Digital would somehow permit a subscriber to renew a service without identifying the subscriber internally to the telephone call. As such, the Examiner's failure to provide factual support for a teaching, suggestion, or motivation to modify Sherer or Edwards constitutes legal error.

Implicit within the case law discussed above is the disapproval of relying upon subjective evidence (i.e., an Examiner's personal impression as to such factors as obviousness, in general, or a motivation to modify a particular reference). The Patent Office is obligated to provide "an administrative record showing the evidence on which the findings are based." The Examiner's personal experiences/impressions/opinions, however, are not part of the administrative record.

As stated in M.P.E.P. § 2142:

the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. (emphasis added)

As can be inferred from this passage, the Examiner's is not free to rely upon all information (i.e., including subjective evidence such as the Examiner's impressions); instead, the Examiner can only rely upon "all factual information" (emphasis added) and "on the basis of facts gleaned from the prior art" (emphasis added).

Since the Examiner's asserted motivation (i.e., to make it possible to extend or renew services without having to go to the service provider in person, saving transportation cost, providing

convenience and to be able to use desired service before/after expiration) is not factually support by the applied prior art, Applicant must presume that the Examiner combined the applied prior art by impermissibly engaging in hindsight reconstruction of the claimed invention based upon Applicant's disclosure. Therefore, for the reasons stated above, the Examiner has not established a *prima facie* case of obviousness.

7. Secondary References Teach Away from the Invention

The secondary references completely teach away from a combination with Sherer and Edwards as each requires the to provide an identifying number over the telephone call in order to renew the service. In Florida, for example, it is stated that to complete the renewal transaction, a caller must provide a "personal identification number (PIN). Similarly, in Wisconsin users must provide a "Mastercard or Visa" card. Finally, Digital, the subscriber must "enter a personal identification number (PIN)." **In all cases, the identifying information is provided through the telephone call** in contravention of the most important aspect of the Applicants' claims.

8. Conclusion

Thus, the Applicants believe that amended claims 1-13 distinguish over the cited art and stand patentable and ready for an indication of allowance. To that end, the Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 103(a) owing to the foregoing remarks. This entire application is now believed to be in condition for allowance. Consequently, such action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

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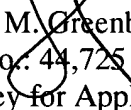
Filed: 12/19/2003

Attorney Docket No.: BOC920030111US1 (1082-15U)

Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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